

FILED  
FEB 4 1968

JOHN F. DAVIS, C

IN THE  
**Supreme Court of the United States**  
October Term, 1968

No. ~~1014~~ 45

ANDERSON'S-BLACK ROCK, INC.,  
*Petitioner,*  
*against*

PAVEMENT SALVAGE CO., INC.,  
*Respondent.*

**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS  
FOR THE FOURTH CIRCUIT**

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IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1968

No. ....

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ANDERSON'S-BLACK ROCK, INC.,

*Petitioner,*

*against*

PAVEMENT SALVAGE CO., INC.,

*Respondent.*

---

**PETITION FOR WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS  
FOR THE FOURTH CIRCUIT**

Petitioner, Anderson's-Black Rock, Inc., defendant below, respectfully prays for issuance of a writ of certiorari to review the judgment and order of the Court of Appeals for the Fourth Circuit, entered November 6, 1968.

**I**

**Orders, Opinions and Judgments Below**

Opinion and mandate of the Fourth Circuit Court of Appeals, Appeal No. 12,020, November 6, 1968, not officially reported, unofficially reported at 159 U. S. P. Q. 513 (A1).

Order of the Fourth Circuit Court of Appeals, filed November 22, 1968 (A13).

Opinion of the District Court, S. D. W. Va., July 25, 1967, on motion for new trial, not reported (A14).

Opinion of the District Court, S. D. W. Va., March 23, 1967, holding patent in suit invalid, not reported (A15).

Final Decree of the District Court, S. D. W. Va., entered May 29, 1967 (A27).

## II

### Statement of the Grounds on Which Jurisdiction of This Court Is Invoked

Sought to be reviewed is the decision and mandate of the Fourth Circuit Court of Appeals, dated and entered November 6, 1968. Jurisdiction to review by writ of certiorari is believed conferred by 28 U. S. C. 1254(1).

## III

### Questions Presented for Review

1. Court of Appeals has decided a federal question in a way which is in conflict with applicable decisions of this Court.

A question below and the principal question here is whether the holding on the matter of aggregations in patents in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545 is still the law and, if so, whether the majority decision of the Fourth Circuit Court of Appeals is in conflict therewith and whether certiorari should be granted under Rule 19(1)(b) of the Rules of the Supreme Court on that account?

2. Aggregation in this case.

Is the holding in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, defining aggregation in the



patent law and determining that mere aggregation is not patentable invention applicable to the factual situation in the present case?

3. Validity of patents claiming aggregation as being affected by long felt want and commercial success.

Assuming that mere aggregation alone cannot result in patentable invention and considering the rather limited role in patent law played by such factors as long felt want and commercial success in determining patentability under the holdings of *A & P Tea Co. v. Supermarket Corporation*, 340 U. S. 147, and *Graham v. John Deere Co.*, 383 U. S. 1, may aggregation coupled with commercial success result in a valid patent?

#### IV

##### **Constitutional Provisions, Statutes Involved**

This case involves the commerce and patent clauses of the Constitution of the United States, Article I, Section 8 (A28), 28 U. S. C. 1254 (A28), 35 U. S. C. 100(b) (A28), 35 U. S. C. 103 (A29), Rules of the Supreme Court, Rule 19(1)(b) (A29).

#### V

##### **Statement of the Case**

###### **A. Proceedings in This Case**

On August 28, 1963 respondent instituted the present action against petitioner for infringement of Neville patent 3,055,280, the patent in suit. Trial was held on April 19 and 20, 1965. In a written opinion the trial Judge held the patent invalid, not reaching the issue of infringement.

A petition for rehearing was subsequently denied and appeal to the Circuit Court of Appeals followed. Argument was held April 3, 1968 and the Appeal was decided November 6, 1968. The Circuit Court of Appeals reversed the District Court on the validity issue and remanded the case for trial on the infringement issue. The remand was stayed by order of the Circuit Court on November 27, 1968 to permit this Petition to be filed in the Supreme Court.

### **B. Nature of Patent in Suit**

The Neville patent in suit discloses and claims a road building machine. There is not claimed a new use for an old machine in terms of process under 35 U. S. C. 100(b), nor a process in conventional form for building a road. The machine is a paver on the side of which is suspended a radiant energy generator. The paver is entirely conventional and is used, for example, to receive hot bituminous material in its hopper, spread the material on a previously prepared road base upon which the paver travels and thereafter to shape the mix to a desired contour. As stated in the Neville patent, the type of radiant energy generator which is hung from the paver is illustrated in prior art patent 2,775,295 to Schwank. This type of generator is principally characterized as one having a perforated lower plate through which fuel is burned in a manner to heat the plate which then becomes a source of radiant or infra-red heat. The claims in the Neville patent define in broad terms such a generator in association with paver means for placing and shaping a pavement material which in most of the claims is identified as bituminous. Such paving means include the usual screed and reciprocating tamper for leveling and smoothing the pavement material deposited by a hopper and the paver's pneumatic tires for compacting the thusly laid and shaped road material.

As explained in the Neville patent the radiant energy generator is employed for two purposes—one for conditioning an old road surface to receive new paving material on top thereof and secondly to condition a side edge of a recently laid strip of material for bonding a second strip thereto in side to side relation.

## VI

### Reasons for Allowance of the Writ

The reason urged by Petitioner for allowing the writ is that the holding by the Court of Appeals decides "a federal question in a way in conflict with applicable decisions of this court". Rule 19(1)(b) of the Rules of the Supreme Court of the United States. The applicable decision in this instance is found in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545. In the dissenting opinion below Circuit Judge Craven states that the majority "ignores the teaching of *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549 (1938) relied upon by the district court."

The definition of aggregation is clearly stated in the *Lincoln Engineering* decision and is quoted in the district court and Court of Appeals dissenting opinions below. The *Lincoln Engineering* decision then concludes as follows:

"We conclude that Butler's [the patentee's] effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of chuck or coupler to old parts or elements *having no new function when operated in connection with the coupler renders the claim void.*"

A recognition of merely those facts which are set forth in the Neville patent compels a determination that the

holding in *Lincoln Engineering* is applicable to them. It is easily seen and never disputed by respondent that the "old parts" namely the claimed pavement shaping means, as for example the hopper, screed, tamper and pneumatic tires of the old paver, all operate in precisely the same manner with no new or modified function whether or not the improved and previous patented radiant energy generator is present. The latter is changed neither in its structure nor in its operation and function as a consequence of its association with the old paver. Indeed, whatever definition of aggregation may be employed, and it has been stated in many forms over the years, such definition would be obviously applicable to the facts at hand.

The "improved form" of radiant energy generator which is the only structure claimed in Neville aside from the conventional paving components mentioned above is shown generally, including the positively claimed "perforate member" or "perforate lower surface", in the Schwank patent 2,775,294. All the claimed elements are, therefore, old which is readily conceded by respondent.

If the question as to whether the rule against aggregation in patent law is to be retained is to be determined by considering whether the association together of the old components would have been obvious under 35 U. S. C. 103, then the judicial admonitions regarding the probability against invention where the elements are all old though otherwise in a proper combination, as opposed to the aggregation here, may be material. Such are to be found in *A & P Tea Co. v. Supermarket Corporation*, 340 U. S. 147; *Baldwin Lima Hamilton Corp. v. Hi-Way Equipment Co.*, 250 F. Supp. 574 and cases cited therein under headnote 3.

The Court of Appeals below largely predicates its finding of invention by Neville on grounds that he was the first

after many years of need to fill the long felt want for an improvement in bonding bituminous concrete grown cold to fresh bituminous material deposited against the concrete in heated condition. The improvement says the majority decision lay in the use of penetrative radiant energy to condition the old material to receive the new. Aside from the fact that this matter was taught in Morcum patent 709,014 and British patent 756,911 with which teaching Neville was constructively chargeable, *Baldwin-Lima Hamilton Corp. v. Hi-Way Equipment Co.*, *supra*, the conclusion thereon ignores the fundamental precept in patent law that commercial success and long felt want are factors used to resolve doubt as to patentable invention and not to inject or create such doubt. In this connection, it was stated in *A & P Tea Co. v. Supermarket Corp.*, *supra*, as follows:

“The Court of Appeals and the respondent both lean heavily on evidence that this device filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability.”

More recently the Supreme Court in *Graham v. John Deere Co.*, 383 U. S. 1, 19-20, found as follows:

“Cook Chemical insists, however, that the development of a workable shipper-sprayer eluded Calmar, who had long and unsuccessfully sought to solve the problem. And, further, that the long-felt need in the industry for a device such as Scoggin’s together with its wide commercial success supports its patentability . . . However, these factors do not, in the circumstances of this case, tip the scales of patentability . . .

See also *Toledo Pressed Steel Co. v. Standard Parts*, 307 U. S. 350, 356-7; *Jungersen v. Ostley and Barton Co.*, 335 U. S. 560, 567; *Kaiser Industries Corp. v. McLouth Steel Corp.*, 400 F. 2d 36, headnotes 4, 10.

If aggregations of elements in the strict sense are either per se unpatentable, as has been the case, or are generally considered unpatentable today due to the improbability of finding unobviousness under 35 U. S. C. 103, it cannot be seen that evidence of commercial success or long felt want relied upon so heavily by the majority below, can establish patentable invention especially when it is considered that all the elements are old and the 1906 patent to Morecum teaches the very advantages of using radiant energy in bonding bituminous asphalt in road work which are taught by Neville though necessarily with an older type radiant energy generator. It is respectfully submitted that it was the availability of propane gas since 1906 in lieu of liquid petroleum then in use which made obvious the feasibility of such generators for mobile use at remote highway locations. The trial testimony of petitioner's expert witness was clear on this point.

It is urged that the Supreme Court should reaffirm its decision in *Lincoln Engineering Co.* by accepting this petition for Writ of Certiorari under Rule 191(b). Only in this manner can the judgment of the Court of Appeals, which is obviously at variance with that decision, be reversed. In the alternative, by accepting the present petition the Supreme Court will have the opportunity to reverse or modify the decision in *Lincoln Engineering Co.* with the result that the decision in the Court of Appeals can be affirmed. If the latter is to be the case it will have a critically important effect on the practice of patent law in the United States.

A reason for retaining the present stricture against patenting aggregations may be found, in the opinion of petitioner, in the language of a provision in the present patent statute. Petitioner alludes in this respect to 35 U. S. C. 100(b) which refers to a new use of an old machine. It reads as follows:

“The term ‘process’ means process, art or method, and includes a new use of a known . . . machine . . .”

The Neville patent claims are addressed to a machine, not a method or process for using a known machine. The single most important component in the machine is the radiant energy generator, the particular form of which was known to the art. If it be assumed that Neville had discovered a new use for the generator in the road construction industry, he was in a position to obtain patent protection through method claims directed to such use. However, by directing his claims to apparatus, which includes the generator in loose association with ordinary street paving components, he not only was thus claiming improper aggregation but was violating the noted statutory provision which sets forth the proper manner of obtaining patent protection in such situations.

If at any time in the future some one discovers a new use for an old device and patents the device separately in conjunction with the needed elements required to give it utility in the new field, he would in many instances have to claim aggregation. By doing so the patent will most probably have novel subject matter as far as the patent art is concerned, but denies a possible patentee of the old device from enjoying all the expected fruits of his creation. Such a proceeding if allowed would entitle anyone to in effect repatent the old device by combining it with those components required to make it useful in a given field. On the face of it a completely different ensemble ensues thereby seemingly easily passing the test of obviousness established in 35 U. S. C. 103 but at the same time limiting the value of the patent on the old device to the patentee who would be precluded from exploiting his invention in what would possibly be its normal commercial areas or their logical extension. The new ensemble, if claimed as a

mere catalogue or aggregation of functionally disassociated elements in the patent of the one who is first to contrive it, as in the instant case, would require no unordinary skill in the making but merely an appreciation of its utility in a selected area of endeavor. Under these circumstances, to predicate patentability on novelty and utility alone would without any question defy the letter and spirit of 35 U. S. C. 103 which requires that the subject matter itself be non-obvious as a condition for patentability. If, on the other hand, he is required to patent the new use of the old device in terms of process instead of apparatus, the question of obviousness would have to be squarely met and the burden would be on applicant for the process patent to show that such use of the old device was unobvious under 35 U. S. C. 103 and that its utility as so used was clearly unexpected considering the entire background and evolution of the invention in the old device and the natural environment for it about which the patent covering the device speaks either expressly or by obvious implication.

That a new use or application of an old device may not be patented when no more than the mere mechanical skill of the art was required to make the adaptation was held in *Cuno Engineering Corp. v. Automatic D Corp.*, 314 U. S. 84. In light of Morecum patent 799,014 which teaches the benefits of utilizing radiant energy to make an improved asphalt joint there is grave doubt that even had Neville claimed a new use for the Schwank type radiant energy generator, in terms of process or method in accordance with 35 U. S. 100(b), patentable invention would result notwithstanding the factor of commercial success found by the Court of Appeals. In any event it is apparent that since Neville, if he had discovered anything, was the first to use a Schwank type radiant energy generator in road building, which well may have been a new use



for this particular type of radiant energy generator, should have sought protection on a process for a new use of the improved device as opposed to claiming the device over again and combining it with conventional paving components in the form of an aggregation.

The Supreme Court has continued to follow the *Lincoln Engineering* doctrine in condemning patents claiming aggregation. See *Toledo Pressed Steel Co. v. Standard Parts*, 307 U. S. 350, 356; *Great A & P Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 151. In the former decision the Court was considering the claimed combination of a special but well known flame torch and a cap for the torch to prevent extinguishment of the flame by wind and rain. The cap was also old as having been used on other type flame torches. The Court ruled that since the cap was serving the same function as it always had without being in any way changed in function or structure due to the torch and the latter continued to produce the same luminescent flame as before, the patent covering the device claimed mere aggregation and was for this reason invalid. The Court of Appeals in not applying this reasoning to the fact situation before it, namely a separately functioning street paver and radiant energy burner supported thereon which continue to function in the claimed association identically as they had individually and prior to such association is in obvious conflict with the decisions of the Supreme Court since the decision in *Lincoln Engineering*.

The district courts around the country have faithfully followed the *Lincoln Engineering* and *A & P Tea Co.*, holdings in condemning patent claims which recite an aggregation of parts. By way of example see *Baldwin-Lima Hamilton Corp. v. Hi-Way Equipment Co.*, 250 F. Supp. 574, 580-581.

The decision of the Court of Appeals below is also in clear conflict with its own prior decisions involving aggregation claims in patents. For example, see *Murdock v. Murdock*, 176 F. 2d 434 (4th Circuit), citing *Young v. John McShain*, 130 F. 2d 31 (4th Circuit), in which Judge Parker presents "an elaborate citation of authorities" holding patents invalid for claiming aggregation including the decision in *Richards v. Chase Elevator Co.*, 158 U. S. 299, 302 wherein the Supreme Court said as follows:

"So long as each element performs some old and well known function, the result is not a patentable combination, but an aggregation of elements."

Even the respondent does not and cannot argue the undisputed fact here that each element recited in the Neville patent claims, namely, the generator for heating the bituminous material and the paving means for depositing and shaping this material "performs some old and well known function" undisturbed by the presence of the other recited elements. The claims are therefore clearly directed to an aggregation of elements and are invalid.

## VII

### Conclusion

Petitioner respectfully requests that this petition for a writ of certiorari be granted.

Respectfully submitted,

NATHANIEL L. LEEK,  
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*Of Counsel:*

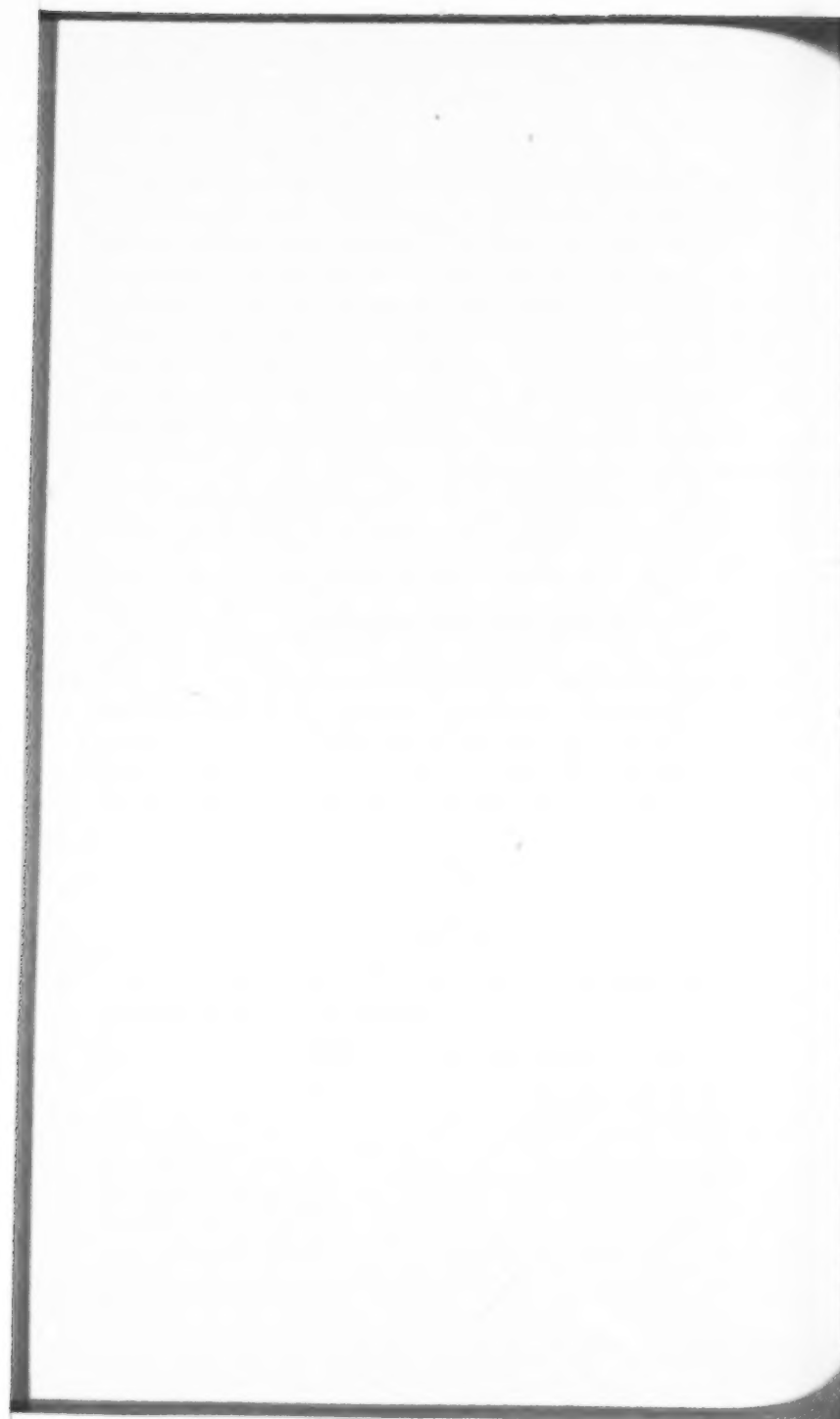
ALAN W. BORST,  
FRANK L. TAYLOR, JR.

Dated: January 30th, 1969

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**APPENDIX TO PETITION**

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## APPENDIX I

### Opinion and Mandate United States Court of Appeals for the Fourth Circuit, November 6, 1968

HAYNSWORTH, Chief Judge:

The patent owner has appealed from a judgment holding the patent invalid for obviousness. Since we conclude that the patent represents a broader advance than the narrow step which occupied the attention of the District Court, we reverse.

The plaintiff, Pavement Salvage Company, Inc., is the owner of Neville Patent No. 3,055,280 covering "Means for Treating Bituminous Pavement." It brought this action against Anderson's-Black Rock, Inc., a highway contractor, who used, in an allegedly infringing manner, a radiant energy generator manufactured and sold by Aeroil Products Company, Inc. Aeroil conducted the defense and is the real defendant.

The patent claims in combination the essential parts of a bituminous concrete paving machine together with a prescribed kind of radiant energy generator. The combination produces a fused bond between a course being laid and an adjacent course previously laid and grown cold. It has met with commercial success and is said to have acceptably answered a problem of long standing.

Bituminous concrete, the familiar black or dark material used for surfacing highways, parking areas, airport runways and taxi-ways, is ordinarily laid in strips by a mobile machine. The material, preheated in a plant to more than 250°, is transported to the site and delivered into the hopper of the paving machine. The paver contains means to spread the material laterally and to smooth, tamp and shape it

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while the machine is in forward motion. It thus produces a continuous strip of bituminous concrete up to twelve feet in width. It is possible to have several pavers working in tandem so that each strip is laid before the adjacent strip has cooled, but that is frequently impossible. The need to maintain traffic and limitations upon the availability of equipment and of an adequate supply of the hot material frequently necessitate the laying of one strip at a time. In that event, the hot material of the second strip will not bind with the cold material of the first strip, leaving what has long been known as a "cold joint."

Where there is a cold joint, water and dirt will infiltrate. After some freezing and thawing, there will be raveling at the joint and early disintegration of the pavement.

The same problem, in a different context, was presented in the early days of the use of bituminous paving materials. When patching was necessary, the absence of bonding between the new, hot material and the old, cold material created the same openings for the seepage of water and dirt with their deleterious effect. Not surprisingly, attempts were made to obtain bonding by preheating the old material. The use of open flames, however, would carbonize the old material, accentuating, rather than alleviating, the difficulty. As early as 1905, Morcom Patent No. 799,014 taught the use of a radiant heat burner, with a solid bottom plate, and with side curtains which could be lowered to prevent the flow of cold air between the burner and the bituminous surface. There followed a number of other patents on heaters and associated equipment for heating the old material during patching or surface smoothing operations.<sup>1</sup>

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<sup>1</sup> Switzer Patent No. 1,136,294 (1915); Flynn Patent No. 2,053,709 (1936); Wells Patent No. 2,254,463 (1941); Fizzell Patent No. 2,705,906 (1955).

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British Patent No. 756,911 (1956) actually taught the use of a radiant heater to soften the edge of a previously laid strip of bituminous concrete before placing an adjacent course.

The difficulty with these earlier patented devices was that they would not work in commercial operation. Open flame devices which carbonized the material were detrimental, while the radiant heaters were ineffective because they produced insufficient penetrative heat to secure bonding of the old material with the new. The consequence was that the industry turned to other methods in its attempt to deal with the problem of cold joints.

When Neville, the patentee, came on the scene, the prevalent and preferred practice was far removed from the old idea of heat treatment. Before the second, adjacent course was laid, the edge of the first course was cut back for several inches, with pneumatic hammers or other devices, to produce a clean vertical surface, which was then painted with hot asphalt. This was expensive, of course, and there were other disadvantages. The cutting disturbed and weakened the structure of the first course, and the final surface was left with a built-in joint. It was not a solution of the cold-joint problem, but the best, known method of minimizing its adverse consequences.

The patentee, in seeking a solution, turned away from current concepts and harked back to the discarded notion of preheating the old material. His patent prescribes the use of a radiant energy generator, having as its base a plate of plastic or metal with many small perforations in it, so that it resembles a grid or gauze. The generator is so designed that combustion occurs in the perforations or adjacent to the perforated base plate. It produces highly penetrative radiant energy, with concentrated wave lengths

*Appendix I*

of approximately three microns. Its use in conjunction with a bituminous paver results in complete bonding between the first course, grown cold, and an adjacent second course. The fusion is complete, and cores disclose no joint into which deleterious substances might seep or be worked. The combination was novel, and it has an obvious utility of practical and economic importance.

Neville was not the inventor of the generator. His is not unlike that disclosed in Schwank Patent No. 2,775,294 (1956). His contribution was the elimination of the cold joint in bituminous concrete paving, and his claims encompass no other uses of such generators. The question, then, is whether the solution "would have been obvious at the time the invention was made to a person having ordinary skill in the art \* \* \*" within the meaning of 35 U. S. C. A. §103, as interpreted in *Graham v. John Deere Co.*, 383 U. S. 1. More specifically, the question is whether, in light of the availability of more efficient radiant energy generators, the answer obviously lay in the theretofore unworkable and discarded art of heat treatment. Our inquiry will be facilitated by resort to those "secondary considerations" which the Supreme Court recognized in *Graham v. John Deere Co.* as "indicia of obviousness or nonobviousness."

The appropriateness of the use of such considerations arises out of the necessity of framing the question of obviousness in terms of available knowledge at the time of the claimed invention and the desirability of avoiding subjective appraisals with high coloration from the patent's disclosure. As the Supreme Court said in *Diamond Rubber Co. v. Consolidated Rubber Tire Co.*, 220 U. S. 428, 435:

"Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and



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expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention."

Similarly, in *S. H. Kress and Co. v. Aghnides*, 4 Cir., 246 F. 2d 718, 723, we said:

"Obviousness does not mean that one skilled in the art can perceive the solution after it has been found and pointed out by someone else; the test of obviousness is as of an earlier time, when the search is on."

The usefulness of such considerations in providing objective indicia to guide decisions is well recognized.<sup>2</sup> The difficulty in obtaining reliable judgments without them was stated by Judge Learned Hand in *Reiner v. I. Leon Co.*, 2 Cir., 285 F. 2d 501, 503-504:

"The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person 'having ordinary skill' in an 'art' with which we are totally unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the

<sup>2</sup> See *Skee-Trainer, Inc. v. Garelick Mfg. Co.*, 8 Cir., 361 F. 2d 895; *Jones Knitting Corp. v. Morgan*, 3 Cir., 361 F. 2d 451; *Bentley v. Sunset House Distributing Corp.*, 9 Cir., 359 F. 2d 140; *Schnell v. Allbright-Nell Co.*, 7 Cir., 348 F. 2d 444; *M. B. Skinner Co. v. Continental Industries, Inc.*, 10 Cir., 346 F. 2d 170; *Allen v. Standard Crankshaft and Hydraulic Co.*, 4 Cir., 323 F. 2d 29; *Lorenz v. F. W. Woolworth Co.*, 2 Cir., 305 F. 2d 102, and dissenting opinion on 106; *Honolulu Oil Corp. v. Shelby Poultry Co.*, 4 Cir., 293 F. 2d 127; *Reiner v. I. Leon Co.*, 2 Cir., 285 F. 2d 501; *Safety Car Heating and Lighting Co. v. General Electric Co.*, 2 Cir., 155 F. 2d 937; *Blumcraft of Pittsburgh v. United States Ct.*, Cl. 372 F. 2d 1014; *Application of Polson*, C.C.P.A., 368 F. 2d 267.

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general history of the means available at the time. To judge on our own that this or that new assemblage of old factors was, or was not, 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it."

With such criteria, however, reliable guideposts can be erected. As we said in *Allen v. Standard Crankshaft and Hydraulic Co.*, 4 Cir., 323 F. 2d 29, 34:

"In approaching the question of obviousness, however, judges should mistrust their subjective notions if there are objective indicia to guide their judgments. Though the answer after the event may appear simple, the Court should not convert its simplicity into obviousness in the face of hard proof of recognized need for the answer, of long, unsuccessful search for the answer by people of skill in the art, of recognition by the industry that the claimed invention was the answer, and of its prompt adoption with attendant commercial success. Even a substantial combination of some of such criteria ought to outweigh a judge's subjective conviction that if one as skilled as he had really looked for the answer, he immediately could have put his finger upon it."

With that introduction, we turn to those secondary considerations as disclosed in this record.

Clearly, there had been a long felt need for a solution of the cold joint problem. Morcom sought it in 1905, and, in his patent, he recites earlier attempts to find it. The cluttered field attests the continuity of the search, and the testimony of the experts demonstrates the gravity of the problem and recognition of continuing need for a more satisfactory solution than cutting back the edge of the first course.

*Appendix I*

If it be said that the solution was dependent upon the development of generators of the Schwank type, the answer did not come with their appearance. Schwank applied for his patent eight years before Neville's application, and the Schwank patent issued more than two years earlier.

That the bituminous paving industry was not expecting a solution through the development of new generators is dramatically illustrated by the incredulity with which it received Neville's concept.

Neville approached the Director of Research of the Pennsylvania Department of Highways, and explained to him the equipment he had and what it would do. The Director testified that Neville was an imposing, impressive man, but that he simply did not believe him.

Neville sought to interest the engineer in charge of the maintenance and construction of Air Force bases, but that official testified that he did not believe Neville's equipment would work. Crowley, the Air Force engineer, remained unconvinced until he received a report of a demonstration Neville finally arranged in California. An official of California's Department of Public Works informed Crowley of the success of the demonstration, adding that, if he had not seen it himself, he could not have believed it. Only after that was the Air Force willing to experiment with Neville's equipment.

The fact that experts in the field received Neville's disclosure with such skepticism and disbelief strongly indicates that, at the time, a person of ordinary skill in the field would not have sought the answer in the disproven method of heat treatment.

After demonstrations verified Neville's claims, they have met with substantial commercial success. The Air Force

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and some states prescribe the use of such equipment; other states use it. Patents have been obtained in the United Kingdom, Canada and Mexico. Foreign and domestic concerns have obtained licenses, and others have purchased the complete equipment from Pavement Salvage without attempting to circumvent the patent. Only Aeroil sought to operate independently and to contest the patent's validity. In doing so, it sold its equipment widely, domestically and abroad.

In promoting the sales of its own products, Aeroil paid high tribute to the new concept. In its catalogues it declared that with the new equipment a "truly homogenous joint is obtained," "a perfect bond." In one of its bulletins it went further when it proclaimed, "This remarkable new development is a dramatic breakthrough \* \* \*. INFRA-RED heat is not new, but the application is revolutionary \* \* \*." Words extolling its own products in sales promotional material should be discounted, perhaps, but the "dramatic breakthrough" was Neville's; the "revolutionary" application of the energy was his, not Aeroil's. Such statements, of course, are quite inconsistent with Aeroil's present position that what Neville did would have been obvious to a person having ordinary skill in the art.

As we have indicated, it is not contended that Neville's claims are anticipated by any prior art patent. It is contended that three or more of them, together, disclose all that Neville claimed, and that because he cannot separately claim the generator or the basic paving machine, he cannot claim the combination. The defense is simply obviousness. The prior art, however, is predominantly a long history of failure to solve the problem by heat treatment. At a time when the industry was concentrating on a quite different, though expensive, partial corrective, there was nothing in

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the junk pile of prior art heat treatment patents to make it obvious to anyone that they supplied the ultimate solution. That this is so is forcefully demonstrated by the duration of the fruitless search, by the skepticism and incredulity with which experts in the field received Neville's disclosure, by its commercial success after demonstrations dissipated the disbelief of the experts, by the conduct of competitors in accepting licenses and purchasing equipment and the bold tribute of the alleged infringer in hailing it as the very antithesis of the obvious.

The District Court was not unimpressed with all of this, but it viewed the question as if it were known that the answer lay in heat treatment and that a generator of the type described by Neville would do the job. Had it been known that the result could be achieved by a generator and a paving machine handled separately but cooperatively, combining the two in one machine for the sake of convenience would have been an obvious step, but that was not known. Neville supplied the whole of the answer which had completely eluded the industry. His contribution cannot be judged without reference to its salient feature, disclosure of the fact that the solution lay in the use of a specified kind of infra-red generator in combination with the basic paving machine.

We reverse the judgment holding the patent invalid and remand for further proceedings on the infringement and other issues.

*Reversed and remanded.*

Craven, Circuit Judge, dissenting:

The court concedes, as I read the opinion, that what makes the thing work is better radiant heat generators of the Schwank type. It is not even contended that Pavement

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Salvage can monopolize such improvements. Nor is it demonstrated to my satisfaction that the combination on one chassis of the paving machine and heat generator is necessary to produce the desired result. Yet, the combination is held patentable, though for all we know the same desired result may be achieved by two machines juxtaposed and separately propelled.

I adopt what was said by Judge Field in his unpublished opinion below:

“[P]laintiff has combined four elements which were known in the prior art. Three of the elements, the screed, leveler and spreader, when constructed on one chassis would not be a patentable invention. However, plaintiff added to this combination the element of a radiant burner. The burner, by itself, is also not patentable. Therefore, the question here is whether the addition of the burner to the paving machine which contains the other three elements has overcome the obviousness of the total combination.

“... Plaintiff's patent is a combination patent. The question of radiant heat was old in the art. The pivotal question would be more logically appear to be, assuming that the radiant heat would work effectively, was it obvious that a more successful machine would evolve if all of the elements were constructed on one chassis? It is my opinion that such a combination was reasonably obvious to one possessing ordinary skill in the art.

“In *A & P Tea Co. v. Supermarket Corporation*, 340 U. S. 147 (1950) the Court made the following statements:

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'It is agreed that the key to patentability of a mechanical device that brings old factors into co-operation is presence or lack of invention.

\* \* \*

'The negative rule accrued from many litigations was condensed about as precisely as the subject permits in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549:

"The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention."

\* \* \*

'The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics.'

"The Court then makes this meaningful observation:

'Courts should scrutinize combination claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements.'

"Plaintiff contends that its combination of elements has solved the age-old problems of asphalt paving; that the invention has, by its combination, produced a new result which has advanced the art, and further points to its com-

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mercial success and the fact that it has answered a long-felt want.

“*Entron of Maryland v. Jerrold*, 295 F. 2d 670 (4th Cir. 1961), set forth the standard for determining whether the elements of a combination exhibit a new result in the following language:

‘The inquiry should more appropriately be directed to whether the elements of the combination perform or produce a new, different or additional function or operation . . . in the combination than that theretofore performed or produced by them.’

“It is my opinion that plaintiff’s combination in no way exceeds the sum of its parts. Each element of the combination performs in the same manner and performs the same job that it formerly did when not in combination. All that plaintiff has done is to construct four elements known in the prior art on one chassis. In regard to plaintiff’s contention of commercial success, see *A & P Tea Co. v. Supermarket Corp.*, *supra*, at 153, wherein the Court stated:

‘The Court of Appeals and the respondent both lean heavily on evidence that this device filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability . . . ’

“Based upon the foregoing, it is my opinion that the Neville patent is not a valid patent . . . ”

I think Judge Field correctly adjudged invalidity of the patent and that the court, in reversing his decision, ignores the teaching of *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549 (1938), relied upon by the district court.

I respectfully dissent.



**APPENDIX II**

**Order of the United States Court of Appeals for the  
Fourth Circuit Filed November 22, 1968**

**UNITED STATES COURT OF APPEALS**

**FOR THE FOURTH CIRCUIT**

**No. 12,020.**

---

**PAVEMENT SALVAGE COMPANY, INC.,**

**Appellant,**

**vs.**

**ANDERSON'S BLACK ROCK, INC.,**

**Appellee.**

**Appeal from the United States District Court for the  
Southern District of West Virginia, at Charleston.**

---

Upon the petition of the appellee by its counsel, and for  
cause shown,

It is ordered that the mandate be, and it is hereby,  
stayed pending application of the appellee in the Supreme  
Court of the United States for a writ of certiorari to this  
Court, provided the application is filed in the Supreme  
Court within the time prescribed by law.

**s/ CLEMENT F. HAYNSWORTH, JR.**  
**Chief Judge, Fourth Circuit.**

**A True Copy, Teste:**

**SAMUEL W. PHILLIPS, Clerk**

**By JO ANN KIRKPATRICK,**

**Deputy Clerk**

**Filed Nov 22 1968**

**SAMUEL W. PHILLIPS**

**Clerk**

**APPENDIX III**

**Opinion of the District Court, S. D. W. Va., July 25, 1967**

July 25, 1967

Edward W. Eardley, Esquire  
Steptoe & Johnson  
Attorneys at Law  
Kanawha Valley Building  
Charleston, W. Va. 25301

Frank L. Taylor, Jr., Esquire  
Kay, Casto & Chaney  
Attorneys at Law  
Charleston National Bank Bldg.  
Charleston, W. Va. 25301

Re: Pavement Salvage Company, Inc.  
v. Andersons'-Black Rock, Inc.  
Civil Action No. 2927

Gentlemen:

I have given careful consideration to the motion of the plaintiff for a new trial and to amend the judgment entered in this case, and have concluded that the motion presents no material or grounds which would justify any change in the conclusions which I reached in this case as set forth in my opinion filed on March 23, 1967.

Accordingly, the motion will be denied and counsel may prepare an appropriate order.

Very truly yours,

JOHN A. FIELDS, JR.  
United States District Judge

**APPENDIX IV**

**Opinion of the District Court, S. D. W. Va.,  
March 23, 1964**

**IN THE DISTRICT COURT OF THE UNITED STATES**

**FOR THE SOUTHERN DISTRICT OF WEST VIRGINIA**

**AT CHARLESTON**

**Civil Action No. 2927**

---

**PAVEMENT SALVAGE COMPANY, INC.,**

**Plaintiff,**

**v.**

**ANDERSONS'-BLACK ROCK, INC.,**

**Defendant.**

---

**OPINION**

Pavement Salvage Company, Incorporated (hereinafter called Pavement Salvage) brought this action for patent infringement against Andersons'-Black Rock, Incorporated (hereinafter called Andersons'). The patent in suit United States Patent No. 3,055,280 for "Means for Treating Bituminous Pavement" (hereinafter called the Neville patent) and was issued on September 25, 1962. Application for the patent was filed February 20, 1959, by Charles A. Neville. The patent was assigned by Neville to Pavement Salvage.

Paving materials for highways consist of two "classes" of concrete—Portland cement concrete and bituminous concrete, the latter being the class in which we are interested. Bituminous concrete is formed by heating an asphaltic material to a sufficient temperature to make it readily

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workable and then mixing it with a heated aggregate (sand or gravel).

The problem of keeping transportation moving and the width of the modern highways makes it desirable to pave the roadway in two or more strips. It is here that the problem is created. The bituminous mixture used must be poured at a temperature of 250° to 290° Fahrenheit in order that it be pliable and capable of being shaped. As is frequently the case, the first strip of asphalt has cooled substantially by the time the adjoining strip is to be laid, creating what is known as a "cold joint". This so-called cold joint results in a poor bonding between the strips, allowing dirt and water to enter between them, ultimately leading to deterioration of the roadway. This deterioration brought about by the cold joint has long been a problem in the field of highway paving.

In an effort to eliminate the cold joint, three procedures have been attempted. One approach was the use of a direct flame on the asphalt in an attempt to soften it sufficiently to produce a homogeneous fusion with the strip being laid. This, however, frequently caused the asphalt to carbonize, resulting in poor bonding of the two strips.

Another theory has been to cut back several inches from the edge of the previously laid strip and paint the strip with hot asphalt. This has proved more successful than the use of the direct flame but ordinarily the cold joint is still present.

The third method is that of using radiant heat rather than direct heat. This procedure was used as early as 1905 in patching asphalt, and is the method which is most widely utilized by the paving industry today.

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The Neville patent description claims a combination of apparatus for delivering penetrative radiant energy to the exposed edge of the primary lane of pavement, placing bituminous material against that lane, and then shaping the newly placed material to desired contour and surface. The apparatus or machine which performs these functions is the invention which is involved in the present controversy.

The Neville patent has nine claims, eight of which Andersons' have allegedly infringed. The claim which is best illustrative of the patent is claim 4, which states:

"4. Bituminous material paving apparatus comprising penetrative radiant energy generating means, bituminous material placing means, and pavement shaping means, said generating means being supported at a distance from the pavement and being movable along the surface whereby exposure of the pavement to generated energy is limited and scorching of the pavement avoided, said generating means comprising an enclosed chamber having a perforate member forming a lower surface of said generating means, and means to supply fuel to said generating means and pass it outwardly through said perforate member while combusting the fuel adjacent said perforate member thereby heating said perforate member to a high temperature whereby penetrative radiant energy is generated and directed against a portion of previously placed bituminous material, said bituminous material placing means being disposed to place additional bituminous material adjacent the section exposed to said penetrative radiant energy, said pavement shaping means being disposed to

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shape the newly placed bituminous material to a desired contour and finish."

The other alleged infringed claims are merely descriptive of the various aspects of the invention.

The patent then merely claims a paving apparatus comprised of: (1) a penetrative radiant energy generating means, (2) a bituminous material placing means and (3) a means for shaping pavement. Prior art indicates that these individual means were known and used for a long period by persons familiar with the art of highway paving prior to the advent of the Neville invention.

In considering the prior art in chronological order, the first relevant patent is United States Patent No. 799,014 (referred to hereafter as the Morcom patent) which was issued in 1905. This patent teaches the repair of asphalt pavement by the use of radiant heat. In describing his invention Morcom stated:

"In my improved construction the heat is conveyed by radiation from the bottom of the combustion-chamber, which is maintained in suitable proximity to the pavement, whereby the heat is effectually applied. \* \* \*

"\* \* \* This heat prepares the said portion of the pavement to receive the new material and unite therewith, as heretofore explained."

Here then was an apparatus patent in 1905 which used radiant heat for the purpose of repairing asphalt. Pavement Salvage contends that this does not apply to the Neville patent because the Morcom invention was for "patching" only, whereas the Neville machine provides

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for the continuous paving along a strip to prevent a cold joint. Concededly, the Morcom patent teaches only the process of radiant heat and does not go into the process of spreading and shaping the bituminous concrete.

In 1915 United States Patent No. 1,136,294 was issued to Charles Switzer. This patent pertained to an invention for heating asphalt pavement. The object thereof was to soften the surface by radiant heat, so that a weighted roller, when run over the pavement, would smooth or shape it. In this patent the radiant heating mechanism and the roller were combined in one frame. Again it should be pointed out that this provided no means for the simultaneous dispersion of the asphaltic material.

United States Patent No. 2,053,709 was issued in 1936 and pertained to a "road reconditioning method and machine". The inventor, B. H. Flynn, stated that:

"The invention relates to the conditioning of gravel roads, asphalt roads, \* \* \* after the surfaces thereof have become so rough and/or undulatory that even the most careful resurfacing in the customary ways will not restore them to the smoothness required. \* \* \* It is the object of my invention, however, to provide for effectively reconditioning the surfaces of the roads \* \* \* without disturbing anything but the surface material, and moreover to provide for reuse of the material."

Flynn's patent goes on to say that the roadway is heated to between 125° and 150° Fahrenheit and the heated surface is then hewed away. The material which is hewed away is spread upon the subsurface and "then sprayed with cut-back asphalt or other suitable binder \* \* \* proving

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a new surface''. This invention combines the heating of the road surface to make it workable and, to a degree, the application of a new surface, by the use of a binding material sprayed from the machine together with fragments of the old road surface. No specific means for heating the road was mentioned nor did it provide any method to shape and smooth the new road surface.

I. M. Wells was granted Letters Patent No. 2,254,463 in 1941 pertaining to a means for constructing and reconstructing road surfaces. This machine consists of a heater to soften the road surface, an apparatus for dispensing aggregate with the semi-liquid surface and a roller for imbedding the aggregate into the surface. The roller would also serve to shape the asphalt. The method of heating is stated thusly:

“ \* \* \* The flames from the burners are indicated as directed down onto the road surface for converting the top material of the road into a semi-fluid mass. However, the heating of the road is not limited to this specific method of heating or to the specific structure shown.”

The patent granted J. L. Fizzell in 1955, Patent No. 2,705,906, performs much the same function as the Flynn and Wells patents. The patent describes an “asphalt road heater planer”. The functions performed consist of heating the road surface and planing a portion therefrom in order to level and smooth it.

There is no need to discuss Patent No. 2,775,294 issued in 1956 to G. Schwank which discloses a radiation burner, since the burner itself is not covered by the Neville patent except as one of the elements of the combination.



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The Neville patent is, as stated before, a combination patent combining the elements of a screed, a spreader, a leveler and a radiation burner. The patent as issued calls for a combination of these elements on one chassis.

The present controversy resulted from the action of Andersons' placing a radiation heater on the front of a Blaw-Knox paver, thus allowing the defendant's machine to perform the same functions with the same basic elements as those described in plaintiff's patent. Pavement Salvage claims that its patent has been infringed whereas defendant, Andersons', in its answer challenges the validity of plaintiff's patent and denies infringement. The two issues, of course, are: (1) is plaintiff's patent valid, and (2) if so, has defendant been guilty of infringement.

In regard to the issue of validity, it is conceded by plaintiff that its invention is merely a combination of elements. Plaintiff further conceded that each of the elements was known to the prior art. However, plaintiff contends that the combination of these elements presents a new and useful result amounting to inventiveness, and further, no single item of the prior art discloses the claimed combination. 35 USCA §103 states that:

“A patent may not be obtained though the invention is not identically disclosed or described as set forth in Section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.”

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The validity of plaintiff's patent is therefore dependent upon this section of the Code and the case law evolving therefrom. Title 35 USCA Section 282 provides that a patent shall be presumed valid and casts the burden of establishing invalidity upon the party asserting it. In commenting on this statutory burden in *Universal Incorporated v. Kay Manufacturing Corp.*, 301 F. 2d 140 (4th Cir. 1962) the Court stated:

"The plaintiff is also entitled to the benefits of the statute, 35 USCA Section 282. \* \* \* We do not think as the plaintiff contends that an infringer must prove invalidity beyond a reasonable doubt. The cases on which the plaintiff relies for this rule, \* \* \* were cases in which priority of discovery of the same invention was the issue rather than invalidity by reason of relevant disclosures of the prior art."

See also *Keiser v. High Point Hardware*, 311 F. 2d 850 (4th Cir. 1962) and *United States Pipe and Foundry Co. v. Woodward Iron Co.*, 327 F. 2d 242 (4th Cir. 1964).

In the present case the defendant, then, must prove that plaintiff's invention was unpatentable, and this must be done by showing that the invention was obvious in the prior art, and that the combination in its patent has created no additional or different function nor produced any unusual or unique results.

In *Graham v. John Deere Co.*, 383 U. S. 1 (1966), the Court referred to the statutory test of obviousness as set forth in 35 USCA §103, and went on to state with respect to the 1952 Patent Act:

"The Act sets out the conditions of patentability in three sections. An analysis of the structure of

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these three sections indicates that patentability is dependent upon three explicit conditions: novelty and utility as articulated and defined in §101 and §102, and nonobviousness, the new statutory formulation, as set out in §103. \* \* \* "

As was stated earlier, plaintiff has combined four elements which were known in the prior art. Three of the elements, the screed, leveler and spreader, when constructed on one chassis would not be a patentable invention. However, plaintiff added to this combination the element of a radiant burner. The burner, by itself, is also not patentable. Therefore, the question here is whether the addition of the burner to the paving machine which contains the other three elements has overcome the obviousness of the total combination.

The plaintiff bases his argument of unobviousness on the following points: The testimony of plaintiff's witnesses Witkoski and Crowley, who stated that during the critical period they were doubtful whether plaintiff's invention would be successful. These witnesses, however, were basing their opinion on the fact that they were doubtful that radiant heat would solve the problem of cold joints. I am of the opinion that this does not get to the heart of validity. Plaintiff's patent is a combination patent. The question of radiant heat was old in the art. The pivotal question would more logically appear to be, assuming that the radiant heat would work effectively, was it obvious that a more successful machine would evolve if all of the elements were constructed on one chassis? It is my opinion that such a combination was reasonably obvious to one possessing ordinary skill in the art.

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Plaintiff relies on *Blaw-Knox v. I. D. Lain Company*, 230 F. 2d 373 (7th Cir. 1956) in which the patent was one for paving heavy concrete highways. There the patent solved problems which had been prevalent for years, and persons skilled in the art had attempted to utilize various combinations and suggestions to solve the problem. However, that is not the situation in the present case. In asphalt paving the only real problem has been the cold joint, and the prior art shows that radiant heat is the most successful answer to the problem.

In *A & P Tea Co. v. Supermarket Corporation*, 340 U. S. 147 (1950) the Court made the following statements:

“It is agreed that the key to patentability of a mechanical device that brings old factors into cooperation is presence or lack of invention.

\* \* \*

“The negative rule accrued from many litigations was condensed about as precisely as the subject permits in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549: ‘The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention.’ ”

\* \* \*

“The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being

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brought into concert, but this is not a usual result of uniting elements old in mechanics.”

The Court then makes this meaningful observation:

“Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements.”

Plaintiff contends that its combination of elements has solved the age-old problems of asphalt paving; that the invention has, by its combination, produced a new result which has advanced the art, and further points to its commercial success and the fact that it has answered a long-felt want.

*Enton of Maryland v. Jerrold*, 295 F. 2d 670 (4th Cir. 1961), set forth the standard for determining whether the elements of a combination exhibit a new result in the following language:

“The inquiry should more appropriately be directed to whether the elements of the combination perform or produce a new, different or additional function or operation \* \* \* in the combination than that theretofore performed or produced by them.”

It is my opinion that plaintiff's combination in no way exceeds the sum of its parts. Each element of the combination performs in the same manner and performs that same job that it formerly did when not in combination. All that plaintiff has done is to construct four elements known in the prior art on one chassis. In regard to plain-

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tiff's contention of commercial success, see *A & P Tea Co. v. Supermarket Corp.*, *supra*, at 153, wherein the Court stated:

“The Court of Appeals and the respondent both lean heavily on evidence that this device filled a long-felt want and has enjoyed commercial success. But commercial success without invention will not make patentability. \* \* \*”

Based upon the foregoing, it is my opinion that the Neville patent is not a valid patent, and hence I find no need to rule on the question of infringement. Counsel may prepare an appropriate order incorporating this opinion by reference therein.

JOHN A. FIELD, JR.  
United States District Judge

Dated March 23, 1967

**APPENDIX V**

**Final Decree of the District Court, S. D. W. Va.,  
March 23, 1967**

IN THE  
UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF WEST VIRGINIA  
Civil Action No. 2927

---

PAVEMENT SALVAGE COMPANY, INC.,

Plaintiff

v.

ANDERSON'S-BLACK ROCK, INC.,

Defendant

---

**FINAL DECREE**

This cause having been heard in open trial before me and having thereafter been briefed by counsel it is, upon consideration thereof, ORDERED, ADJUDGED AND DECREED as follows:

1. That my Opinion dated March 23, 1967, be in lieu of findings of fact and conclusions of law.
2. That United States Letters Patent No. 3,055,80 in suit is invalid.
3. That the complaint herein be, and the same hereby is, dismissed with costs to the Defendant.

Enter: This 29th day of May, 1967.

JOHN A. FIELD, JR.

Judge

Approved by:

FRANK L. TAYLOR, JR.

EDWARD W. EARDLEY

## APPENDIX VI

### Constitutional Provisions, Statutes and Rules Involved

*Constitution of the United States, Article I, Section 8 (1787):*

Section 8. The Congress shall have Power \* \* \*

\* \* \*

To regulate Commerce with foreign Nations, and among the Several States, and with the Indian Tribes;

\* \* \*

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

\* \* \*

Act of June 25, 1948; c. 646; 62 Stat. 928; *Title 28, United States Code, Section 1254:*

Section 1254. Courts of appeals; certiorari; appeal; certified questions.

Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

\* \* \*

35 U. S. C. 100(b)

When used in this title unless the context otherwise indicates—

\* \* \*



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(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

\* \* \*

*Patent Act of July 19, 1952; Public Law 593, 82nd Congress, 2d session; c. 950; 66 Stat. 792; Title 35, United States Code, Section 103:*

Section 103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Rules of the Supreme Court of the United States

PART V. JURISDICTION ON WRIT OF CERTIORARI

19.

CONSIDERATIONS GOVERNING REVIEW ON CERTIORARI

\* \* \*

1. (b) Where a court of appeals . . . has decided a federal question in a way in conflict with applicable decisions of this court; . . .

\* \* \*